

## **II. RESPONSE TO OFFICE ACTION**

### **A. Status of the Claims**

Claims 1-53 were pending at the time of the Action. Claims 1-8, 10-11, and 22-53 stand rejected, and claims 9 and 12-21 are objected to. Claims 12 and 45 have been amended in the Amendment contained herein, and claims 54-108 have been added. No new matter is added by the Amendment and new claims, and support for the Amendment and new claims can be found in the specification and claims as originally filed. Therefore, claims 1-108 are pending after entry of the Amendment.

### **B. The Obviousness Rejections Are Overcome**

#### **1. The Standard for Establishing a Prima Facie Case of Obviousness**

It is well settled that “[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP § 2142.

To establish a *prima facie* case of obviousness, the Action must show: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference teaches or suggests all of the claim limitations. *See In re Vaeck*, 947 F.2d 488, (Fed Cir. 1991). With respect to element (1), “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01. If any one of the three elements is missing, an obviousness rejection cannot be maintained.

## 2. Claims 1-8, 10-11, and 22-53 Are Not Obvious Over Lim in View of Audousset

Claims 1-8, 10-11, and 22-53 are rejected as obvious over Lim et al. (US 6,461,391) (“Lim”) in view of Audousset et al. (US 5,769,903) (“Audousset”). The Action alleges that Lim teaches all of the elements of the rejected claims except for a benzomorpholine coupler. The Action asserts that the deficient teachings of Lim are supplied by the teachings of Audousset. Applicants traverse.

When obviousness is based on the teachings of multiple prior art references, the Action must establish some “suggestion, teaching, or motivation” that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tech Air, Inc. v. Denso Mfg, Mich, Inc.*, 192 F.3d 1353, 1358-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). As stated by the Federal Circuit, “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint of piecing together the prior art to defeat patentability the essence of hindsight.” *Id.*

Thus, it has been consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teaching in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Therefore, “particular finding must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *Id.* “In other words, the examiner must show reasons that

the skilled artisan, confronted with the same problems as the inventor and with the knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Applicants respectfully assert that the cited references do not supply a reason, suggestion, or motivation to combine Lim and Audousset. As stated in M.P.E.P. § 2143.01: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The motivation to combine the references proffered by the Action is that Lim “suggests the use of heterocyclic couplers in the dyeing composition.” If this was a sufficient finding to support a *prima facie* case of obviousness, Lim could be readily combined with any patent application disclosing any heterocyclic compound. Such ease of combining references is not the law. The term “heterocyclic derivative” used in Lim encompasses a vast number of compounds, and the Action makes no attempt to show that a person of skill in the art would have been motivated by this generic disclosure to combine the specific heterocyclic compound disclosed in Audousset (6-benzomorpholine) with the compounds in Lim. Such a combination is clearly a product of hindsight reconstruction, which has been expressly forbidden by the Federal Circuit.

For at least these reasons, the rejection of claims 1-8, 10-11, and 22-53 as obvious over Lim in view of Audousset is improper and should be withdrawn.

### **C. Newly Added Claims**

Applicants note that new claims 54-97 are combinations of certain of the previously presented claims. For example, new claim 54 is a combination of claims 1, 2, 7, 12, 13, 15, and 16. As such, new claims 54-97 are patentable over the cited references for the same reasons discussed above.

Applicants note that new claims 98-108 are submitted in response to the Action's statement that claims 9 and 12-21 would be allowable if rewritten in independent form. Claim 98 is claim 9 rewritten in independent form, and claims 99-108 are claims 12-21 rewritten in independent form. Because the Action states that the prior art of record does not teach or disclose the limitations of these claims, Applicants submit that these claims are in condition for allowance.

**D. Conclusion**

Applicants believe that the present document is a full and complete response to the Office Action dated August 5, 2005. The present case is in condition for allowance, and such favorable action is respectfully requested.

### **III. REQUEST FOR EXTENSION OF TIME**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of three months to and including February 5, 2006, in which to respond to the Office Action dated August 5, 2005. Because February 5 falls on a Sunday, the due date is extended to Monday, February 6 pursuant to 37 C.F.R. § 1.7. Pursuant to 37 C.F.R. § 1.17(a)(2), a check in the amount of \$1020.00 is enclosed, which is the fee for a three-month extension of time for a large entity. If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/LORE:006US.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3035 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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